

**REMARKS**

Reconsideration and allowance in view of the following remarks are respectfully requested.

Upon entry of this Response, claims 27-32 and 46-63 will be pending in the present application.

No amendments to the claims have been made in this response.

Claims 1-26 and 33-45 were previously cancelled.

**Claims 27-32, 46-51 and 58-63 stand rejected under 35 U.S.C. § 102(b)**

The Examiner rejects Claims 27-32, 46-51 and 58-63 under 35 U.S.C. § 102(b) as being anticipated by Hicklin (U.S. 6,176,479 B1). Applicants respectfully traverse this rejection for the reasons presented below.

In accordance with published United States Patent and Trademark Office ("USPTO") patent examination policy, "[a] functional limitation must be evaluated and considered, just like any other limitation of the claim - for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." That is, a functional limitation is often used in association with an element, ingredient or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. See, for example, *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976)

There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

"When evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and

then evaluate the elements in isolation. Instead, the claim as a whole must be considered.”  
MPEP § 2106, citing *Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981).

### Claim 27

Independent Claim 27, as previously presented, recites, *inter alia*, “an implant for attachment to a hyoid bone, comprising: an implant body; a first attachment zone configured for attachment to a first portion of a hyoid bone; a second attachment zone configured for attachment to a second portion of a hyoid bone”. Numerous examples of such implant are shown in the Figures of the present application.

In making the rejection, the Examiner contends:

Hicklin teaches a device 10 at fig. 1 capable of being implanted and attached to a hyoid bone, or positioned in a pharyngeal structure. The structure of the arms 11 and 17 is considered to be the implant body. The device has a first attachment zone 44 capable of being attached to a first portion of a hyoid bone. The device has a second attachment zone 52 capable of being attached to a second portion of a hyoid bone.

Such contention is flawed in a number of ways. First, Hicklin is directed toward a clamping device for allowing a user to easily attach two objects together and contains no disclosure whatsoever of being implantable. Instead, the basic design of the clamping device 10, which utilizes handles 60, 61 connected to threaded driving members 36,39 projecting from one side, would generally preclude the device from being suitable whatsoever from being used as an implant. For example, if the clamping device 10 were attached to the hyoid bone of a patient as suggested by the Examiner, the threaded driving members and associated handles would obviously project outward from the neck of a patient in a manner that would preclude them from being implantable (as they would project beyond the skin of the patient).

Second, the clamping device 10 of Hicklin relies on three arm members 11, 17 and 25, each having jaw members 44, 48 and 52, to allow the a user to clamp two objects together. (see col. 5, lines 29-32) As shown in the Figs., jaw members 44, 48 and 52 are angled members designed simply to “grip about” two objects (see col. 5, lines 31-32) and are not intended, nor structured in any manner, to be “attached” to anything whatsoever, let alone be attached to a hyoid bone.

Third, the Examiner's analysis completely disregards the third arm member of the clamping device 10 of Hicklin, a piece not indicated whatsoever by Hicklin as being optional, but instead evidently critical for operation of the clamping device 10. Inclusion of such third arm member would make the clamping device 10 of Hicklin even more unsuitable for the use suggested by the Examiner.

Accordingly, it is submitted that the cited reference of Hicklin does not disclose or suggest each and every element as set forth in Claim 27, and thus does not anticipate the claim.

#### Claims 28-32

Claims 28-32 depend from Claim 27 and thus are likewise believed to be allowable over Hicklin for at least the same reasons as Claim 27.

Additionally, Claims 28 and 30, as originally presented, respectively recite "wherein the connection comprises a flexible portion of the body" and "wherein the connection comprises a flexible element carried by the body". Elements 49 and 50 of Figs. 7C and 7D of the present application show non-limiting example embodiments of such a connection comprising a flexible portion of the body, and element 53 of Fig. 8A shows a non-limiting example of a flexible element carried by the body. In complete contrast, the clamping device 10 of Hicklin relies solely on a rigidly pinned connection, and therefore contains no disclosure or suggestion whatsoever of a connection comprising a flexible element or portion as recited in Claims 28 and 30.

#### Claim 46

Claim 46, as previously presented, recites, *inter alia*, "an implant for positioning in a pharyngeal structure". As previously discussed in regard to Claim 27, the clamping device 10 of Hicklin is clearly not suitable for implanting with a body, let alone for implanting in a pharyngeal structure. Accordingly, Hicklin does not anticipate Claim 46.

#### Claims 47-49

Claims 47-49 depend from Claim 46 and thus are likewise believed to be allowable over Hicklin for at least the same reasons as Claim 46.

**Claim 50**

Claim 50 recites a similar structure to that recited in Claim 27 which, as previously discussed, is believed allowable over Hicklin. Additionally, Claim 50, as previously presented, recites, *inter alia*, “an implant for attachment to a hyoid bone for providing space for passage of a patient’s larynx” (emphasis added). A person of ordinary skill in the art would readily appreciate that in order to provide space for passage of a patient’s larynx, the patient’s hyoid bone would need to be manipulated in an outward fashion (i.e., distorted into a less U-shaped form). As Hicklin discloses a device solely for clamping two elements together, clearly a person of ordinary skill in the art would not look to the teaching or disclosure of Hicklin for a solution for manipulating a hyoid bone in an outward fashion (i.e., for providing space for passage of a patient’s larynx). Accordingly, Hicklin does not anticipate Claim 50.

**Claim 51 and 58-61**

Claims 51 and 58-61 depend from Claim 50 and thus are likewise believed to be allowable over Hicklin for at least the same reasons as Claim 50.

**Claims 62 and 63**

Claims 62 and 63, as previously presented, recite similar structures to that recited in Claim 27 which, as previously discussed, is believed allowable over Hicklin. Hence, Claims 62 and 63 are likewise believed allowable over Hicklin for at least the same reasoning as Claim 27.

In view of the foregoing, withdrawal of the rejection of Claims 27-32, 46-51 and 58-63 under 35 U.S.C. § 102(b) is respectfully requested.

**Claims 52-57 stand rejected under 35 U.S.C. § 103(a)**

The Examiner rejects Claims 52-57 under 35 U.S.C. § 103(a) as being unpatentable over Hicklin. Applicants respectfully traverse this rejection for the reasons presented below.

Claims 52-57 depend (either directly or indirectly) from Claim 50 which, as previously discussed, is believed allowable over Hicklin. Accordingly, Claims 52-57 are likewise believed allowable over Hicklin for at least the same reasoning as Claim 50. Additionally, Applicant completely disagrees with the Examiner's contention that a ball and socket joint, a joint comprising wires, a joint comprising a ribbon, or a clevis pin are "obvious variants" of an equivalent structure to that disclosed by Hicklin. As shown in Fig. 1 of Hicklin, arm members 11 and 17 are pivotally connected by a pin. Such pinned connection occurs roughly at an end of arm 17 and at a point along arm member 11, roughly 1/3 of the way from an end. The pinned connection acts as a fulcrum between the two portions of arm member 11. It is submitted that a person of ordinary skill in the art would not consider a ball and socket joint, a joint comprising wires, a joint comprising a ribbon, or a clevis pin as being "obvious variants" of such a pinned arrangement as such variants do not appear to be even feasible in such arrangement.

In view of the foregoing, withdrawal of the rejection of Claims 52-57 under 35 U.S.C. § 103(a) is respectfully requested.

**Summary and Conclusion**

In summary, it is submitted that all of the pending claims, Claims 27-32 and 46-63, are patentably distinguishable over the references of record. All objections and rejections have been addressed.

It is respectfully submitted that the present application is in condition for allowance and a Notice to the effect is earnestly solicited.

No additional claim fees are believed to be required as a result of the above amendments to the claims. However, if any fees are determined to be due, the Commissioner is authorized to charge any such fees, to deposit account no. 14-1270.

Respectfully submitted,  
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